

### REQUEST TO WITHDRAW PREMATURE FINALITY

Initially, Applicant respectfully requests withdrawal of the finality of the Office Action as being premature. See, MPEP § 706.07(d). Applicant submits that the finality is improper because the rejection of Claims 9 and 12 under 35 U.S.C. §101 was a new rejection that was not necessitated by the previous Amendment. See, MPEP § 706.07(a). Therefore, Applicant respectfully requests that the present Amendment be entered as a matter of right.

Moreover, while Applicant acknowledges that amendments were made, it is clear that those amendments were not the reason for the new rejection, because the reasons for the rejection under 35 U.S.C. §101 applied equally to both the amended and unamended language. Therefore, it is clear that the section 101 rejection should have been entered earlier and Applicant should not be penalized for a late rejection that, in addition, is made final.

### REMARKS

This application has been carefully reviewed in light of the Office Action dated June 30, 2010. Claims 1 to 7 and 9 to 15 are presented for examination, of which Claims 1, 7 and 9 are in independent form. Claims 13 to 15 have been added. Reconsideration and further examination are respectfully requested.

Claims 9 and 12 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Without conceding the propriety of the rejection, Applicant has amended Claims 9 and 12 to comply even more fully with 35 U.S.C. §101. Accordingly, Applicant respectfully requests the withdrawal of the rejections of Claims 9 and 12 under 35 U.S.C. §101.

Claims 1 to 3, 5, 7 and 9 were rejected under 35 U.S.C. §103(a) over U.S. Patent 6,972,863 (Parry) in view of U.S. Patent 7,062,534 (Henry). Claim 4 was rejected under 35 U.S.C. §103(a) over Parry, Henry, and alleged admitted prior art (AAPA); Claim 6 was rejected over Parry, Henry, and U.S. Patent 6,137,590 (Mori); and Claims 10 to 12 were rejected over Parry, Henry, and U.S. Patent 6,446,329 (Mukai). Applicant respectfully traverses the rejections and submits that the claims are distinguishable from the applied references for at least the following reasons.

The pending independent Claims 1, 7 and 9 generally relate to processing and outputting of a document. An image on a document is read. The image contains image storage information representing a location where an original image of the document is stored. A user is authenticated by using authentication information. The original image of the document is searched from an image storage device which stores the original image of the document. The original image is searched on the basis of the image storage

information when the user is authenticated. A destination is set for the original image of the document. In a first case the transmission of the original image of the document is set, and in a second case the transmission of the original image of the document is not set. In the first case, the destination for the original image of the document is automatically set in accordance with the authentication information. In the first case, the destination is set to an address of the user authenticated and the set destination is different from the image processing apparatus. Moreover, in the first case, the destination is automatically set independently of a manual designation upon the authentication of the user and independent of the image on the document. In the second case, the destination for the original image of the document is manually set. The original image of the document searched is output to the set destination.

One feature of independent Claims 1, 7, and 9 is that in setting the destination for the original image of the document, in the first case, the destination for the original image of the document is automatically set in accordance with the authentication information. By virtue of this feature, in one case of setting a destination for the original image of the document, a user ordinarily need not select the address of the user from among various addresses in order to set the address of the user as the destination.

The Office Action concedes that Parry “does not disclose expressly setting a destination for the original image independent of a manual designation”, and cites to column 4, lines 25 to 56 of Henry as allegedly teaching, in particular, the setting means referred to in Claim 1. See, Office Action at pages 4 and 5. In the opinion of the Applicant, however, there is nothing in Parry or Henry that would teach or suggest that the

destination for the original image of the document is automatically set in accordance with authentication information to the address of the authenticated user.

Henry purportedly relates to an “information caching system and method in which destination e-mail addresses and facsimile numbers are automatically stored for each user of a sending device”. Henry, col. 1, lines 8 to 10. As understood from Henry, when a user logs into a sending device (Fig. 4, block 400), the user is permitted to call up saved information, including an address, a number, or a distribution list from the address book of the user (Fig. 4, block 402). The user selects information (Fig. 4, block 422) from the saved information and the user can initiate a sending process (Fig. 4, block 418). Thus, in Henry, it is the user who sets the destination address, which is unlike the claims herein, which specify that the destination for the original image of the document is automatically set in accordance with authentication information to the address of the authenticated user.

Moreover, Henry fails to disclose the storage of the address of the user who inputs the address. It stands to reason, therefore, that Henry could not possibly disclose or suggest an automatic setting of a destination for an original image of a document in accordance with authentication information to an address of the authenticated user.

Applicant submits that a combination of Parry and Henry, assuming such combination would even be permissible, would fail to teach or suggest that a destination is set for the original image of the document as provided in the independent claims.

Specifically, the combination of Parry and Henry fail to teach or suggest that in a first case the transmission of the original image of the document is set, and in a second case the transmission of the original image of the document is not set; and that in the first case, the destination for the original image of the document is automatically set in accordance with

the authentication information. Moreover, Parry and Henry fail to teach or suggest that in the first case, the destination is set to an address of the user authenticated and the set destination is different from the image processing apparatus, and that in the first case, the destination is automatically set independently of a manual designation upon the authentication of the user and independent of the image on the document. For at least these reasons, the independent claims 1, 7 and 9 are believed to be allowable over Parry and Henry.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as a reference against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of independent Claims 1, 7 and 9, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our Costa Mesa, CA office by telephone at (714) 540-8700. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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